



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,602	05/26/2005	Ulrich Sander	33997.0112	2248
26712	7590	08/07/2006	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/536,602

Applicant(s)

SANDER, ULRICH

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18, 23-24 and 25 is/are rejected.
- 7) ☒ Claim(s) 19-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/26/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the pre-amendment filed on 5/26/2005. It is noted that in the pre-amendment, applicant has amended the specification, the abstract and submitted a substitute specification. Regarding to the claims, applicant has canceled claims 1-11, and added a new set of claims, i.e., claims 12-25, into the application.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings contained three sheets of figures 1-6 were received on 5/26/2005. These drawings are objected by the Examiner for the following reason(s).

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to a system for forming an intermediate image as recited in claim 25 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

Art Unit: 2872

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The substitute specification filed on 5/26/2005 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because applicant has failed to file a statement that the substitute specification does not contain any new matter.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities: The specification is objected to because it does not have headlines such as for the purpose of providing a clear framework of the specification. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Art Unit: 2872

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

8. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. See present specification in page 8. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied

Art Unit: 2872

upon to overcome any objection, rejection, or other requirement imposed by the Office.

The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 12-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al (U.S. Patent No. 6,097,538).

Watanabe et al disclose a binocular microscope. The microscope as described in columns 5-6 and shown in figure 6 comprises the following features: A barrel (3) supporting a magnification-changing system (60) wherein the optical axis of the magnification-changing system is extended in a horizontal direction and perpendicular to the vertical direction in which a light beam from an object (S) extends through the objective system (7); an observation system (17) supporting a reflecting prism (19), a lens system (20), a reflective mirror (21) and a binocular tube (22) wherein the light passing through the magnification-changing system is first reflected by the prism (19) in a direction substantially opposite and deviates from a parallel offset of the mentioned vertical direction from an object passed

through the objective lens system (7) and then reflected by the reflective mirror (21) to pass through the binocular tube (22).

11. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (U.S. Patent No. 3,459,464).

Smith discloses a stereomicroscope. The stereomicroscope as described in columns 2-3 and shown in figs. 1-2 comprises the following features: An optical lens system (2) for providing a light beam from an object (O) in a first direction; a zoom lens system (14-16); a set of mirrors (12, 13, 17) wherein the mirror (12) is a double-side mirrors which is understood as a mirror having two reflecting elements which each elements comprises a front surface acts as a reflector and a rear surface supports the front surface; an observation system having prism element (21) and lens (22) which in combination defines a viewing tube for the stereomicroscope. The mirror (17) arranged after the zoom system (14-16) for reflecting light passing through the zoom system in a direction which opposites to the direction defined by the light beam from the object to the first reflecting mirror of the mirror (12). The direction of light reflected from the mirror (17) to the second reflecting mirror of the mirror (12) is about 180 degrees with respect to the direction defined by the object to the first reflecting surface of the mirror (12). It is also noted that the light reflected from the mirror (17) to the second reflecting mirror of the mirror (12) is substantially toward the object. The second reflecting mirror of the mirror (12) is used to reflect light to the viewing tube having prism (21) and lens system (22).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12-18, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (EP 1,120,676, submitted by applicant) in view of Westphal (U.S. Patent No. 4,576,450).

Nakamura discloses a stereomicroscope. The stereomicroscope as described in pages 3-4 and shown in figs. 2-3 comprises the following features: a housing supporting a reflective prism (P1) and a zoom system (22) wherein the optical axis of the zoom system is extended in a horizontal direction and perpendicular to a vertical direction in which a light beam from an object (T) is defined; The light transmitted through the zoom system is then reflected by a series of reflecting elements disposed in a variable body tube (4) located after the zoom system before go through an eyepiece (5). It is noted that Nakamura does not clearly disclose that the variable body tube (4) comprises reflecting elements for reflecting light from a main body of the microscope to its eyepiece. However, the use of a variable body tube connected a main body of a microscope and its eyepiece wherein the variable body tube comprises two reflecting elements and a lens system for the purpose of providing a means for adjusting the height of the eyepiece with respect to the main body of the microscope is known to one skilled

in the art as can be seen in the microscope provided by Westphal. In particular, in columns 3-4 and figs. 1-2, Westphal discloses a microscope having a variable body tube (3) disposed between a main body of a microscope and its eyepiece. The variable body tube (3) supports a first reflecting element (13) and a second reflecting element (33) wherein a lens system (15) is disposed between the two mentioned reflecting elements for forming an intermediate image to be viewed by an eyepiece (5). In other words, the use of the variable body tube supporting two reflecting elements and a lens system in place of the variable body tube (4) provided in the stereomicroscope of Nakamura will satisfy the following features: first, the first reflecting element (13) will reflect the light from the zoom system in a direction deviates from the direction in which light from an object defines; second, the light reflected from the first reflecting element (13) is reflected to the second reflecting element (33) in a direction substantially opposite to the direction defined by the objective and substantially towards the object; third, the light reflected from the second reflective element (33) is guided to the eyepiece in a direction opposite to the direction in which the light go to the zoom system; the reflecting element (P1) provided by Nakamura will acts as a reflecting element for reflecting light from an objective system to the zoom system and the rear surfaces of the reflecting element (P1) and the reflective element (33) will face toward one another in the combined product provided by Nakamura and Westphal. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the stereomicroscope provided by Nakamura

by using a variable body tube supporting two reflecting elements and a lens system disposed between the two reflecting elements as suggested by Westphal for the purpose of adjusting the height of an eyepiece with respect to the microscope supporting the eyepiece and for guiding the light from an objective to the eyepiece without image reversal.

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Westphal as applied to claim 23 above, and further in view of Blaha et al (U.S. Patent No. 4,175,826).

The combined product as provided by Nakamura and Westphal does not clearly suggest an optical system comprises reflecting elements for eliminating an image reversal which reflecting elements comprises roof edges. However, the use of a variable body tube supporting a set of optical reflecting elements for guiding light from an objective system of a microscope to its eyepiece and for adjusting the height of the microscope wherein one of the reflecting elements comprises a roof edge is known to one skilled in the art as can be seen in the microscope provided by Blaha et al. See column 2 and figs. 1-2, optical element (6). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Nakamura and Westphal by using a set of reflecting elements which comprises roof edge(s) as suggested by Blaha et al for the purpose of guiding the light from an objective to the eyepiece without image reversal and for reducing the number of optical reflecting elements being used in the system.

Allowable Subject Matter

15. Claims 19-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

a) Claim 19 is allowable with respect to the cited art, in particular, the EP reference No. 1,120,676 and the U.S. Patent Nos. 3,458,244; 3,459,464; and 6,097,538 by the limitations related to the structure of the reflecting elements and their arrangement for reflecting light from the zoom system to the viewing tube. While the use of two reflecting elements arranged into one piece and their reflecting surfaces facing opposite to each other is disclosed in each of the US Patent No. 3,458,244 (see prism elements (20, 21)) and patent No. 3,459,464 (see mirror 12); however, the cited art does not disclose a set of three reflectors wherein the first reflector located after a zoom system for reflecting light passing through the zoom system in a direction deviating from the light direction from an object by more than 135 degrees; a second reflector for reflecting light from the first reflector to a viewing tube; and a third reflector disposed before the zoom system for reflecting light from the object to the zoom system wherein the zoom system is arranged along an axis substantially perpendicular to the light direction from the object and the rear surfaces of the second and third reflectors are joined to one another.

b) Claim 20 is allowable with respect to the cited art, in particular, the EP reference No. 1,120,676 and the U.S. Patent Nos. 3,458,244; 3,459,464; and 6,097,538 by the limitations related to the structure of the reflecting elements and their arrangement for reflecting light from the zoom system to the viewing tube. While the use of two reflecting elements arranged into one piece and their reflecting surfaces facing opposite to each other is disclosed in each of the US Patent No. 3,458,244 (see prism elements (20, 21)) and patent No. 3,459,464 (see mirror 12); however, the cited art does not disclose a set of three reflectors wherein the first reflector located after a zoom system for reflecting light passing through the zoom system in a direction deviating from the light direction from an object by more than 135 degrees; a second reflector for reflecting light from the first reflector to a viewing tube; and a third reflector disposed before the zoom system for reflecting light from the object to the zoom system wherein the zoom system is arranged along an axis substantially perpendicular to the light direction from the object and the second and third reflector are rotatable in such a way that the light from the object is selectively guided into the viewing tube without go through the zoom system.

c) Claims 21 and its dependent claim 22 are allowable with respect to the cited art, in particular, the EP reference No. 1,120,676 and the U.S. Patent Nos. 3,458,244; 3,459,464; and 6,097,538 by the limitations related to the structure of the reflecting elements and their arrangement for reflecting light from the zoom system to the viewing tube. While the use of two reflecting elements arranged

into one piece and their reflecting surfaces facing opposite to each other is disclosed in each of the US Patent No. 3,458,244 (see prism elements (20, 21)) and patent No. 3,459,464 (see mirror 12); however, the cited art does not disclose a set of three reflectors wherein the first reflector located after a zoom system for reflecting light passing through the zoom system in a direction deviating from the light direction from an object by more than 135 degrees; a second reflector for reflecting light from the first reflector to a viewing tube; and a third reflector disposed before the zoom system for reflecting light from the object to the zoom system wherein the zoom system is arranged along an axis substantially perpendicular to the light direction from the object and a mirror layer that reflects light from the front and rear surfaces thereof is arranged between and shared by the second and third reflectors.

Conclusion

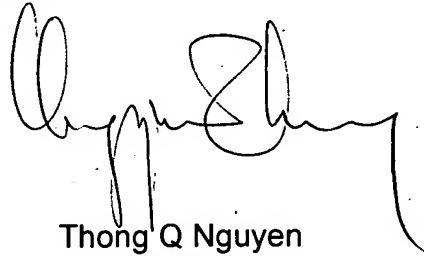
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Thong Q. Nguyen', is positioned above the printed name.

Thong Q Nguyen
Primary Examiner
Art Unit 2872
